



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/217,112 | 12/21/1998 | KYOU-WOONG KIM | 678-206-(P85 | 8740 |

7590 06/11/2002

DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
UNIONDALE, NY 11553

EXAMINER

CUMMING, WILLIAM D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2684

DATE MAILED: 06/11/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/217,112 | 12/21/1998 | KYOU-WOONG KIM | 678-206-(P85 | 8740 |

26021 7590 05/08/2002

HOGAN & HARTSON L.L.P.
~~500 S. GRAND AVENUE~~
~~SUITE 1900~~
~~LOS ANGELES, CA 90071-2611~~

Dilworth & Barrese, LLP
333 Earle Drington Blvd
Uniondale, NY
11553

| |
|----------|
| EXAMINER |
|----------|

CUMMING, WILLIAM D

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2684

DATE MAILED: 05/08/2002

7
6/12/02

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/217,112

Applicant(s)

KIM

Examiner

WILLIAM D. CUMMING

Art Unit

2684

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

DETAILED ACTION

Election/Restrictions

1. This application contains claims 11-13 are drawn to an invention nonelected without traverse in Paper No. 4. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

4. Claims 1, 3, 5, 9 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Tam**.

Tam discloses a method for generating a unique incoming call alert tones (note abstract). The method comprises the steps of setting and storing the unique call alert for each one or more service options, note claim 15. Recognizing a service option from the paging message, note figure 7A. Retrieving an incoming call alert tone corresponding to the recognized service option and generating the retrieved incoming alert tone, note claim 15.

5. Claim 1 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Murata, et al**.

Murata, et al discloses a method for generating a unique incoming call alert tones (note abstract). The method comprises the steps of setting and storing the unique call alert for each one or more service options, note claim 8. Recognizing a service option from the paging message, note figures 2-5C. Retrieving an incoming call alert tone corresponding to the recognized service option and generating the retrieved incoming alert tone, note claim 8.

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

6. Claims 1, 3, 5, 9 and 10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Tanka, et al.**

Tanka, et al disclose a method for generating a unique incoming call alert tones (note abstract). The method comprises the steps of setting and storing the unique call alert for each one or more service options, note claim 2. Recognizing a service option from the paging message, note figures 2-7. Retrieving an incoming call alert tone corresponding to the recognized service option and generating the retrieved incoming alert tone, note claim 2.

7. Claims 1 and 9 and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Shinozaki**.

Shinozaki discloses a method for generating a unique incoming call alert tones (note abstract). The method comprises the steps of setting and storing the unique call alert for each one or more service options, note column 1, line 49 to column 2 line 15. Recognizing a service option from the paging message, note figure 2. Retrieving an incoming call alert tone corresponding to the recognized service option and generating the retrieved incoming alert tone, note column 1, line 49 to column 2 line 15.

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

8. Claims 1 and 9 and are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Kyrolahti, et al.**

Kyrolahti, et al discloses a method for generating a unique incoming call alert tones (note abstract). The method comprises the steps of setting and storing the unique call alert for each one or more service options, note column 1, line 61 to column 3 line 46. Recognizing a service option from the paging message, note figure 3. Retrieving an incoming call alert tone corresponding to the recognized service option and generating the retrieved incoming alert tone, note column 1, line 61 to column 3 line 46.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

11. Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cashman** in view of **Murata, et al or Tanaka, et al or Shinozaki or Kyronlahti, et al or Tam**.

Cashman disclose all subject matter, except for setting, storing, retrieving and generating an unique call alert tone for one or more service option. The examiner take Official notice that the use of setting, storing, retrieving and generating an unique call alert tone for one or more service option is notorious old and well known in the telephone art. **Murata, et al or Tanaka, et al or Shinozaki or Kyronlahti, et al or Tam** is evidence that this is such. Hence, it would have been obvious to one below ordinary skill in the art at the time the claimed invention was made to incorporate the well known use of setting, storing, retrieving and generating an unique call alert tone for one or more service option in the method of **Cashman** in order for the user to distinguish quickly and audibly what service option, AMPS or CDPD is paging.

Allowable Subject Matter

12. Since allowable subject matter has been indicated, applicant is encouraged to submit formal drawings in response to this Office Action. The early submission of formal drawings will permit the Office to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

14. Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

15. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new grounds of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Leslie, Wagai, et al, and Uyeno, et al disclose the setting, storing, retrieving and generating an unique call alert tone for one or more service option.

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

18. A shortened statutory period for reply to this final action is set to **expire THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2684

Final Rejection 04/12/02 3:38 PM

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D. CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday, Wednesday, and Thursday 9:00am to 8:30pm, EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **DANIEL HUNTER** can be reached on 703-308-6732. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

WILLIAM D. CUMMING
Primary Examiner
Art Unit 2684

wdc
April 12, 2002



WILLIAM CUMMING
PRIMARY PATENT EXAMINER
WASHINGTON, DC 20231
(703) 305-4394 (703) 308 6306
FAX
william.cumming@uspto.gov